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# Ex parte appeals FAQ

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▾ Appeal filing

▾ Q. How do I know which judges will decide my appeal?

A. Judges are assigned to appeals according to a PTAB standard operating procedure based upon considerations such as their educational background, experience, workload, and conflicts.

▾ Q. How do I know the Board received my appeal?

A. When the Board assumes jurisdiction of an appeal, it issues a docketing notice to the appellant which includes the application number for the appeal; and an appeal number. This docketing notice verifies that the Board received the appeal.

▾ Q. Do I file documents for an appeal with the Board?

A. No, appeal documents are not filed with the Board. Appellants are encouraged to file appeal documents online via the Patent Center. Appeal documents can also be filed via facsimile to 571-272-8300 or by postal mail to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

▾ Q. When can I file an appeal?

A. Applicants may appeal a patent application after any claim has been twice rejected (i.e., two non-final rejections) or after the claim is subject to a final rejection.

**▼ Q. How long do I have to file an appeal?**

A. After receiving the second rejection of a claim, applicants have six (6) months to file a notice of appeal. After filing a notice of appeal, an applicant becomes an appellant. Appellant has two (2) months after filing a notice of appeal to file an appeal brief.

**▼ Q. Can I appeal an objection?**

A. No, the Board's jurisdiction is limited primarily to review of examiner's rejections based on unpatentability. Examiner's objections are not appealable to the Patent Trial and Appeal Board. The Board also does not review matters of examiner procedure, such as a requirement for restriction or election of species, finality of a rejection, non-entry of claim amendments, and holdings of abandonment. Applicants can seek review of these matters by filing a petition to the Director of the U.S. Patent and Trademark Office.

**▼ Q. What information should I include in an Appeal Brief?**

A. By USPTO rule, an appeal brief should include the following sections:

- (i) identification of the real party in interest;
- (ii) identification of related appeals, interferences, and trials;
- (iii) a summary of claimed subject matter;
- (iv) arguments as to why the examiner's rejection was in error; and
- (v) a listings of the claims subject to appeal.

Further details as to the requirements for each of these sections may be found at MPEP 1205.

If an appellant submits a brief lacking one or more of the above sections, the Office will notify the appellant of the reasons for non-compliance and give the appellant a time period within which to file an amended brief. If the appellant does not file an amended brief that overcomes the reasons for non-compliance within the set time period, the appeal will be dismissed.

**▼ Timing of an appeal****▼ Q. How long does an appeal take?**

A. The average appeal takes approximately 15 months. The Office refers to this time from when the Board receives jurisdiction over the appeal to the issuance of a decision as “appeal pendency.”

▼ **Q. Is there a way to expedite an appeal?**

A. If the examination of an application is expedited, the appeal will be similarly expedited. No separate request is required to expedite an appeal. But if the examination of an application is not expedited, there is no process before the Board to request expedited disposition of the case.

▼ **After notice of appeal**

▼ **Q. Can I have an interview with the examiner after filing a notice of appeal?**

A. If you have filed a notice of appeal but has not filed an appeal brief, you normally may have one interview with the examiner. Except in unusual situations, interviews are not permitted after the appeal brief is filed.

▼ **Q. Do I have to file a reply brief?**

A. You are not required to file a reply brief in response to an examiner’s answer unless the examiner’s answer includes a new ground of rejection. When the examiner’s answer includes a new ground of rejection, you must either file a reply brief to maintain the appeal; or file a reply to reopen prosecution.

If an appellant fails to respond to an examiner’s answer containing a new ground of rejection, the appeal may be dismissed regarding the claims subject to the new grounds of rejection. When all appealed claims are subject to the new ground of rejection, the entire appeal may be dismissed.

▼ **Q. How long do I have to file a reply brief?**

A. You should file a reply brief within two months of: (1) the date of the examiner's answer; or (2) a decision refusing to grant a petition to designate a new ground of rejection in an examiner's answer.

Extensions of time are generally not permitted, but may be granted when a reply cannot be filed within two months. In such cases, the period for submitting a reply brief will be extended for sufficient cause and for a reasonable time specified. The request for an extension must be filed by the date the reply brief is due. Filing a request for an extension does not mean the extension has been granted.

▼ **Q. If I do not file a reply brief, is there anything else I must do before my appeal is submitted to the Board?**

A. Yes. Even if no reply brief is filed, the appeal forwarding fee must be paid prior to expiration of the period of time for filing a reply brief. If the forwarding fee is not paid, the appeal will be dismissed.

Further, if you wish to request an oral hearing, such a request must also be made by the due date for the reply brief.

▼ **Q. What should I include in a reply brief when the examiner's answer does raise any new grounds of rejection?**

A. By USPTO rule, a reply brief must contain certain information: (1) an identification page setting forth the appellant's name(s), the application number, the filing date of the application, the title of the invention, the name of the examiner, the art unit of the examiner, and the title of the paper (i.e., Reply Brief); and (2) arguments as to why the examiner's rejection was in error. Generally, the arguments should not repeat those presented in the appeal brief, but instead respond to arguments made in the examiner's answer.

▼ **Q. What should I include in a reply brief when the examiner made one or more new grounds of rejection in the examiner's answer?**

A. If the examiner's answer contains any new grounds of rejection, the reply brief should either: (1) request the appeal be maintained; or (2) request that prosecution be reopened. When an appellant requests the appeal be maintained, the reply brief must address each new ground of rejection. The reply brief cannot include any claim amendments, affidavits, or other evidence.

When an appellant requests that prosecution be reopened, an appellant may file claim amendments, affidavits, or evidence responsive to the new ground(s) of rejection.

**▼ Q. Can I amend claims after filing a notice of appeal?**

A. Yes, with certain restrictions.

Amendments filed after a notice of appeal, but before the appeal brief, may be filed to:

- Cancel claims.
- Comply with any requirement of form expressly set forth in a previous action by the examiner.
- Present rejected claims in better form for consideration on appeal.
- Amend the specification or claims upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

Amendments filed on or after an appeal brief may be filed to:

- Cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding.
- Rewrite dependent claims in independent form.

**▼ Q. Can I submit affidavits and/or new evidence with my appeal brief and/or reply brief?**

A. No, an appellant cannot include any new affidavits or evidence in the appeal brief and/or reply brief.

**▼ Examiner's answer****▼ Q. May the examiner make a new rejection in an examiner's answer?**

A. An examiner can make a new ground of rejection on appeal. The examiner must, however, clearly designate in the examiner's answer that the answer contains a new ground of rejection, and must provide the appellant with the option to either maintain the appeal or reopen prosecution. If an appellant believes an examiner's answer includes an undesigned new ground of rejection, and the appellant wants to reopen prosecution to enter an amendment, affidavit, or evidence in response, then the appellant may file a petition seeking to designate the examiner's answer as containing a new ground of rejection. The filing of this petition will put the appeal on hold until the petition is decided. If the appellant's petition is granted, the appeal is terminated and prosecution is reopened. If the appellant's petition is denied, then the appeal continues, and the appellant has the option to file a reply brief.

▼ **Q. What should I do if I think the examiner made a new ground rejection in the examiner's answer?**

A. If an appellant believes an examiner's answer includes an undesigned new ground of rejection, an appellant may file a petition seeking to designate the examiner's answer as a new ground of rejection, which would terminate the appeal, or continue with the appeal by filing a reply brief addressing the new rejection.

▼ **Hearing**

▼ **Q. Do I have to travel to the Office if I want a hearing?**

A. No. Hearings may be held in-person or via video or telephone. In-person hearings can take place at the Office's headquarters in Alexandria, Virginia or at any of the USPTO regional offices located in Detroit, Denver, Dallas, and San Jose.

▼ **Q. Will the examiner be at the hearing?**

A. Probably not. Although an examiner can attend a hearing, it is rare that an examiner appears. If the examiner will appear at the hearing, the Board will notify the appellant in advance.

▼ **Q. Can I bring a witness to a hearing? Can I bring evidence?**

A. Witnesses are generally not permitted in appeal hearings. Demonstratives, including PowerPoint slides, may be permitted, if they do not go beyond the written record on appeal. The use of demonstratives is at the judges' discretion. For additional information about hearings, an appellant should consult the Board's [hearings guide](#).

**▼ Q. How do I request a hearing?**

A. Appellants must file a written request for an oral hearing within two (2) months after the date of the examiner's answer or the date of filing a reply brief, whichever is earlier. The written request should be in a separate paper captioned "REQUEST FOR ORAL HEARING." The request should be filed with the appropriate fee.

**▼ Q. Will a hearing be held in every instance if requested?**

A. The Board typically honors requests and schedules a hearing. However, in rare circumstances, if the Board decides that a hearing is not necessary, it will notify the appellant. For example, the Board may decide that an oral hearing is not necessary if the Board has become convinced, prior to hearing, that the examiner's position cannot be sustained.

**▼ Q. How will I find out when the hearing will take place?**

A. The USPTO will issue a Notice of Oral Hearing setting forth the date, time, and hearing room location for your hearing. This notice is typically issued a few weeks before the scheduled date of the hearing.

**▼ Q. Can a hearing be rescheduled?**

A. Yes, if an appellant finds it absolutely necessary to request a hearing be rescheduled, then the appellant may respond to a Notice of Hearing by: (1) confirming attendance for the originally scheduled hearing; and (2) submitting a request to reschedule the date of the hearing. The rescheduling request may be submitted either simultaneously with the response to the Notice of Hearing or submitted subsequently. Rescheduling and postponement requests are, however, discouraged.

**▼ Q. If I request a hearing, can I later decide not to attend?**

A. Yes. If you decide that an oral hearing is no longer necessary, you can waive the hearing. You should notify the Board as soon as possible after deciding to waive a hearing.

**▼ Q. Can I present slides at the hearing?**

A. Yes. However, you must request the audio visual equipment in writing at least three days before your scheduled hearing, so that the equipment can be set up. No new evidence is permitted.

▼ **Q. Will a written transcript of the hearing be available?**

A. Yes, the Board provides court reporters for all hearings, and transcripts are made available to parties usually within four weeks after the hearing.

▼ **Q. Who can attend the hearing?**

A. Most hearings are open to the public and anyone may attend, subject to space limitations of the hearing room. Some hearings may be designated nonpublic, with only parties associated with the case allowed to observe.

▼ **Appeal outcome**

▼ **Q. If I win on appeal, do I get a patent immediately?**

A. No, the Board does not have the authority to issue a patent. If an appellant is successful on appeal, the application is returned to the examiner who will decide whether to issue a patent for the application or to make a new rejection.

▼ **Q. What happens if I lose on appeal?**

A. If an appellant is unsuccessful on appeal, the appellant may continue to prosecute the application before the examiner, request rehearing by the Board, or seek judicial review by the federal courts.

▼ **Q. Can the Board raise a new ground of rejection in an appeal decision?**

A. Yes, the Board may raise a new grounds of rejection in an appeal decision. In such cases, the Board will designate the new ground of rejection under a subheading that says "NEW GROUNDS OF REJECTION."

▼ **Contacting PTAB**

▼ **Q. Can I contact the judges for help with an appeal?**

A. No, you may not try to contact a judge for help with an appeal. Other than during a hearing, judges will not discuss a particular appeal with an appellant. Judges will rely on the written record, including an appellant's brief(s), to decide the appeal.

If you have questions about preparing or filing documents on appeal, you can contact the examiner for the application or the Pro Se Assistance Program at 1 866 767 3848. If you have questions about a docketed appeal, i.e., the appeal has an appeal number, you may contact the Board's Appeals Division via telephone at 571-272-9797 or by mail at the following address:

Appeal Related Matters  
Patent Trial and Appeal Board  
US Patent and Trademark Office  
PO Box 1450  
Alexandria, Virginia 22313-1450

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